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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/520,662 08/28/95 DOMINGUEZ DE WALTER

L HOE-94/F-249

ACQUAH, S EXAMINER

12M2/0122

ART UNIT PAPER NUMBER

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1207

DATE MAILED: 01/22/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8/28/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-26 are pending in the application.  
Of the above, claims are withdrawn from consideration.
- ☐ Claims have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 1-26 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).
- ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

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Art Unit: 1207

15. Claims 1, 6, 8-12, 14, 16 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 8 recite transesterification "of a lower aliphatic ester of an aromatic....". Said recitation is confusing and/or indefinite.

Claims 1, 11, 12 and 14 recite " acid and derivatives". The recitation is indefinite. It is not clear what derivatives are contemplated.

Claims 6 and 22 recite "compounds which donate crosslinking structural groups". Said recitation is indefinite.

Claim 10 recites "can be prepared". The recitation is indefinite.

16. Claims 8, 9 and 16 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The independent claim requires only "an aromatic dicarboxylic acid or .... ester of an aromatic dicarboxylic acid". The dependent claims that recite hydroxycarboxylic acids are, therefore, not further limiting.

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 1207

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Horlbeck et al and Hashimoto et al.

The cited prior arts disclose processes for the preparation of polyesters in the presence of catalysts. The prior art processes have features and characteristics essentially as claimed. See the abstract and columns 1 and 3-5 of Horlbeck et al, and column 3 of Hashimoto et al.


18. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1026 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yaw et al.

The cited prior art discloses process for making polyesters in the presence of catalysts. The process is essentially as claimed. See columns 2-4.

19. Any inquiry concerning this communication should be directed to Examiner Sam A. Acquah at telephone number (703) 308-2436.

ACQUAH:tcj  
January 17, 1996

  
SAMUEL A. ACQUAH  
PRIMARY EXAMINER  
GROUP 1200